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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,652	05/17/2001	Koichiro Kashiwagi	NEC N01270	3896
27667	7590	08/09/2005	EXAMINER	
HAYES, SOLOWAY P.C. 130 W. CUSHING STREET TUCSON, AZ 85701			SINGH, RAMNANDAN P	
			ART UNIT	PAPER NUMBER
			2646	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/859,652

**Applicant(s)**

KASHIWAGI, KOICHIRO

**Examiner**

Ramnandan Singh

**Art Unit**

2646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Apr. 07, 2005 has been entered.

### **2. Status of Claims**

Claims 1, 7, 9 and 15 are amended.

Claims 1-15 are pending.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: Claim 1 recites the limitation "through **said or** said voice receiving section of said handset" in lines 5-6, page 2. Delete the term "**said or**". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7 and 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Miner et al [US 5,652,789].

Regarding claim 1, Miner et al teach a telephone set having a compute-based electronic assistant to receive and manage incoming calls to a subscriber [Abstract], as shown in Fig. 5, comprising:

at least one handset (earpiece on the subscriber's phone) [col. 38 lines 13-14];  
and

a notifying/instructing unit (i.e. electronic assistant) [Fig. 5], used to make an instruction to continuously notify to a user via a voice receiving section of the handset that an awaiting state is kept at a time of a response to an incoming call until a voice of a party placing the call is heard through the voice receiving section of the handset [Fig. 27; col. 38, lines 1-33; col. 2. lines 26-48].

Claim 9 is essentially similar to claim 1 and is rejected for the reasons stated above apropos of claim 1.

Regarding claim 2, Miller et al further teach the telephone set, wherein the notifying/instructing unit (i.e. electronic assistant) is used to make an instruction to transmit a predetermined signal voice (i.e. caller's spoken self-identification) and to

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continuously notify that said awaiting state is kept until the voice of the party on the other end is heard [Fig. 27; col. 38, lines 1-7].

Claim 10 is essentially similar to claim 2 and is rejected for the reasons stated above apropos of claim 2.

Regarding claim 3, Miller et al further teach the telephone set comprising:  
a unit (i.e. voice recognition unit) used to generate the predetermined signal voice [col. 6, lines 23-38].

Claim 11 is essentially similar to claim 3 and is rejected for the reasons stated above apropos of claim 3.

Regarding claim 4, Miller et al further teach the telephone set, wherein the notifying/instructing unit is used to make an instruction to transmit a predetermined display signal (i.e. menu) and to continuously notify that the awaiting state is kept until the voice of the party on the other end is heard [col. 8, lines 50-59].

Claim 12 is essentially similar to claim 4 and is rejected for the reasons stated above apropos of claim 4.

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Regarding claim 5, Miller et al further teach the telephone set, comprising a unit (i.e. electronic assistant) used to generate the predetermined display signal [col. 8, lines 50-59].

Claim 13 is essentially similar to claim 5 and is rejected for the reasons stated above apropos of claim 5.

Regarding claim 6, Miller et al further teach the telephone set, wherein the notifying/instructing unit, after having stopped transmission of the incoming call at the time of the response (i.e. within a prescribed period of time) to the incoming call, notifies continuously that the awaiting state is kept until the voice of the party on the other end is heard [col. 38, lines 15-21].

Claim 14 is essentially similar to claim 6 and is rejected for the reasons stated above apropos of claim 6.

Regarding claim 7, Miller et al further teach the telephone set, wherein the notifying/instructing unit, after the transmission of the incoming call has been stopped by an off-hook operation of a handset (i.e. accepts the call) at the time of the response to the incoming call, continuously notifies that the awaiting state is kept until the voice of the party on the other end is heard [col. 8, lines 1-29; Fig. 27].

Claim 15 is essentially similar to claim 7 and is rejected for the reasons stated above apropos of claim 7.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miner et al as applied to claims 1 and 9 respectively above, and further in view of Kung et al [US 6,633,635 B2].

Regarding Claim 8, Miner et al do not teach expressly an internet protocol (IP) telephone set to transmit and receive a voice signal to and from a packet network using an internet protocol.

Kung et al teaches multiple call waiting in a packetized communication system, as shown in Figs.1-3, including a broad-band IP-based network [col. 1, lines 9-15], comprising a broadband residential gateway (BRG) 300 [col. 3, line 30 to col. 4, line 58]; an announcement server 220 [col. 9, lines 39-46]; and a voice gateway 232 [col. 12, lines 53-67]. Fig. 3 shows a block diagram of a local control apparatus (broadband residential gateway) which can support **IP telephones** [col. 21, lines 41-61]. Further,

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Kung et al discloses implementing a call queue function wherein the subscriber may use any type of broadband communication device including POTS phone [Abstract; col. 32, lines 49-51].

Miner et al and Kung et al are analogous art because they are from a similar problem solving area, viz. , telephonic communications.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the IP telephone set with Miner et al.

The suggestion/motivation for doing so would have been to provide multiple call waiting in an Internet Protocol Telephony Network [ Kung et al; col. 1, lines 53-58].

Claim 16 is essentially similar to claim 8 and is rejected for the reasons stated above apropos of claim 8.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) Miner et al [US 6,021,181 ] teach an electronic voice mail handling system [Figs. 1-4];



(ii) Penning [US 5,745,562] teaches a voice announce device for a telephone set (100) shown in Fig. 1 [Abstract; Fig. 2; col.1, lines 61-63;; col. 1, lines 27-53; col. 3, line 65 to col. 4, line 5; Fig. 4; col. 4, line 67 to col.5, line 44]; and

Hanrick et al [US 20030068020 A1] teach a telephone set shown in Fig. 5; Para: 0071; 0084; claims 9-12].

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramnandan Singh whose telephone number is (571) 272-7529. The examiner can normally be reached on M-TH (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramnandan Singh  
Examiner  
Art Unit 2646

  
**SINH TRAN**  
**SUPERVISORY PATENT EXAMINER**